UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/825,431	04/03/2001	Stuart D. Baker	209.1001	2071

7590 01/05/2007 DAVIDSON, DAVIDSON & KAPPEL, LLC 485 Seventh Avenue, 14th Floor New York, NY 10018	**EXAMINER** NGUYEN BA, PAUL H

ART UNIT	PAPER NUMBER
2176	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/05/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

PTOL-90A (Rev. 10/06)

	Application No.	Applicant(s)
Office Action Summary	09/825,431	BAKER ET AL.
	Examiner	Art Unit	
	Paul Nguyen-Ba	2176	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _23 October 2006_.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _1-27, 41-59, 71 and 72_ is/are pending in the application.

  4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _1-27, 41-59, 71, and 72_ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

  Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

  Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

  a)☐ All b)☐ Some * c)☐ None of:

  1.☐ Certified copies of the priority documents have been received.

  2.☐ Certified copies of the priority documents have been received in Application No. _____.

  3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

  * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
   Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
   Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application

6)☐ Other: _____ .

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1.   A request for continued examination under 37 CFR 1.114, including the fee set

forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this

application is eligible for continued examination under 37 CFR 1.114, and the fee set

forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action

has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on

10/23/2006 has been entered.

2.   Claims 1-27, 41-59, 71 and 72 are currently pending. Claims 1, 18, 41, 49, 57,

71, and 72 are independent claims.

Claim Rejections - 35 USC § 103

3.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
such that the subject matter as a whole would have been obvious at the time the invention was made to a
person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived
by the manner in which the invention was made.

4.   **Claims 1-27, 41-59, 71 and 72 are rejected under 35 U.S.C. 103(a) as being**

unpatentable over Dickinson, III et al. ("Dickinson"), U.S. Patent Application

Publication No. 2003/0196098, in further view of Liu et al. ("Liu"), U.S. Patent No.

6,760,752.

Regarding independent claim 1, Dickinson discloses:

A digital communication system to denote confidentiality of a digital communication comprising (see Title and Abstract):

a memory containing a program executable by the processor to (see para [0018] → The system takes the form of a program executing on a conventional general purpose computer):

attach a privileged attribute to a digital communication (see paras [0023], [0025], and [0030-0031] → The policy modules operate on confidential attachments to e-mails to require either encryption, signature, or both, in order to enforce attorney-client privileges);

create a privileged distribution list of at least one intended recipient (see paras [0022-0023] → Dickinson teaches a recipient policy list); and *a second memory containing a program executable by a processor to:*

restrict access to the privileged digital communication to the at least one intended recipient (see paras [0009], [0024] and [0030-0031]: The policy modules operate on confidential attachments to e-mails to require either encryption, signature, or both, in order to enforce attorney-client privileges);

restrict routing of the privileged digital communication to the at least one intended recipient (see paras [0009], [0024] and [0030-0031]: Dickinson teaches a recipient policy list) and,

> store the privileged digital communication in a segregated location
>
> (...) on a data storage device (see paras [0010] and [0040-0041] → The
>
> messages may be stored at specific segregated destinations or queues).

Dickinson does not explicitly disclose Applicant's newly amended claim language ("a first memory", "a second memory", "associate the privileged distribution list with the digital communication") that limits the digital communication system to a system wherein the communication itself controls the disposition of where the communication may be sent (see Applicant's Argument pg. 12). Dickinson also does not explicitly disclose a segregated location specifically for privileged digital communications.

However, Liu discloses a secure transmission system wherein a first memory attaches an encrypted/confidential signed message as an attachment to an e-mail message and transmits the e-mail message to the intended recipient of the distribution list (see col. 1 lines 54-65 and col. 2 lines 45-51).

Liu further discloses a second memory that restricts access and routing of the encrypted/confidential communication (see col. 2 lines 1-4, 62-67; col. 3 lines 35-52).

Moreover, Liu discloses storing the digital communication in a segregated location for privileged communications (see col. 21 lines 6-20).

Since both references are from the same field of endeavor, the motivational purpose of providing secure data transmissions between Internet users as disclosed by Liu would have been recognized in the pertinent art of Dickinson. It would have been

obvious at the time the invention was made to a person having ordinary skill in the art to

modify the teaching of Dickinson with the teachings of Liu to include a system wherein

the communication itself controls the disposition of where the communication may be

sent and a segregated location specifically for privileged digital communications.

Independent claim 18 incorporates substantially similar subject matter as

independent claim 1 and is rejected along the same rationale.

Regarding claim 2, Dickinson, in view of Liu, disclose wherein the at least one

intended recipient is a plurality of intended recipients (see para [0031] → policies can be

applied to users, either individually or by groupings).

Regarding claim 3, Dickinson, in view of Liu, disclose a mail server (see para

[0034]); a segregated server housing the segregated location (...) (see paras [0034-

0038]); wherein the program is further executable to send a copy of the communication

to the segregated server (see paras [0010], [0034-0038], and [0040-0041]), and a

segregated location for privileged digital communications.

Regarding claims 4, 5, 7, 8, 19, 20, 41, 42, 46, 47, 51, and 52, Dickinson, in

view of Liu, disclose a communication system (i.e. e-mail) containing a plurality of user

specified information fields, such as source field specifying an e-mail address for the

source of the message, a destination field specifying one or more destination e-mail

addresses for the message, a subject field specifying a subject for the message, a

body field specifying the body of the message containing textual and/or graphics data,

and an optional attachment field, specifying one or more files to be transmitted with the

message. Other user specified fields include, but are not limited to, priority of the

message, identity of the sending agent, and the date and time of the message (see

para [0019]).

Dickinson does not explicitly disclose sending a copy as a blind carbon copy, a

characteristic including a department of a corporation using the system, forwarding of

the communication, and copying and cutting contents into another location.

However, it was commonly known to those of ordinary skill in the art and would

have been obvious at the time the invention was made to a person having ordinary skill

in the art to include sending a copy as a blind carbon copy, a characteristic including a

department of a corporation using the system, forwarding of the communication, and

copying and cutting contents into another location (e.g. Microsoft Outlook, Hotmail,

Yahoo! Mail, etc.) for the motivational purpose of comprising the major common

functional components of a user-friendly e-mail system.

Regarding claims 6 and 50, Dickinson, in view of Liu, disclose configuring

access rights to the digital communication when the document is opened and to enforce

said access rights by managing access to the digital communication and controlling the

manipulation of its contents (see paras [0009], [0024] and [0030-0031]).

Regarding claims 9, 21, and 54, Dickinson, in view of Liu, disclose executing

automatically and attaching the privileged attribute or the executable module to

particular communications according to predetermined selection criteria (see para

[0022-0031]; please refer also to the rationale relied upon to reject independent claim

18).

Regarding claims 10, 22, and 55, Dickinson, in view of Liu, disclose a

confidentiality notice that is displayed to a user and acknowledged by the user before

displaying the privileged communication (see para [0039] → i.e. notification actions).

Regarding claim 11, Dickinson does not explicitly teach acknowledging a

confidentiality notice by clicking on a GUI button. However, it was commonly known to

those of ordinary skill in the art and would have been obvious at the time the invention

was made to a person having ordinary skill in the art to include clicking on a GUI button

for the motivational purpose acknowledging a pop-up window (*compare with*

"confidentiality notice").

Regarding claims 12, 23, 56, and 59, Dickinson, in view of Liu, disclose the system wherein the privileged digital communication is encrypted and decryption methods if a predetermined condition is met (see Abstract and para [0007] et seq.).

Regarding claims 13 and 24, Dickinson, in view of Liu, disclose a server object and a client object (see paras [0034-0037]).

Claims 14, 15, 17, 25, 26, and 53 incorporate substantially similar subject matter as independent claim 1 and are rejected along the same rationale.

Regarding claims 16 and 27, Dickinson, in view of Liu, does not explicitly teach that the client object is a plug-in to a pre-existing communication system. However, Dickinson discloses the S/MIME protocol to exchange secure e-mail messages (see para [0034]). It is well known to a skilled artisan that most plug-in modules (e.g. Navigator) are based on MIME file types that simply plugs in to the existing system.

Therefore, it was commonly known to those of ordinary skill in the art and would have been obvious at the time the invention was made to a person having ordinary skill in the art to include a plug-in to a pre-existing communication system for the motivational purpose of adding a specific feature or service to a larger system.

Regarding claim 43, Dickinson, in view of Liu, disclose executing automatically

and attaching the privileged attribute to particular communications according to

predetermined selection criteria (see para [0022-0031]).

Regarding claims 44, Dickinson, in view of Liu, disclose a confidentiality notice

that is displayed to a user and acknowledged by the user before displaying the

privileged communication (see para [0039] → i.e., notification actions).

Regarding claims 45, Dickinson, in view of Liu, disclose the system wherein the

privileged digital communication is encrypted and decryption methods if a

predetermined condition is met (see Abstract and para [0007] et seq.).

Claim 48 incorporates substantially similar subject matter as independent claim 1

and is rejected along the same rationale.

With respect to independent claims 49, 71 and 72, please refer to the

rationale relied upon to reject independent claim 18, which contains substantially similar

subject matter, as discussed above.

Claims 57 and 58 incorporate substantially similar subject matter as

independent claim 18 and are rejected along the same rationale.

Response to Arguments

5.   Applicant's arguments with respect to newly amended claims filed on 10/23/2006

have been considered but are moot in view of the new ground(s) of rejection.

The new grounds of rejection include the addition of the Liu et al. patent, which is

being relied upon for teaching the newly added limitation, "*a first memory*", "*a second*

memory", and "*associate the privileged distribution list with the digital communication*".

Applicant's arguments focus on the prior art's failure to teach this particular

limitation. One of ordinary skill in the art would have been motivated at the time of the

invention to arrive at the instant invention by combining Dickinson and Liu.

Conclusion

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Paul Nguyen-Ba whose telephone number is (571) 272-

4094. The examiner can normally be reached on 11 am - 7 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Heather Herndon can be reached on (571) 272-4136. The fax phone

number for the organization where this application or proceeding is assigned is 571-

273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

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For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

PNB
11/21/06

Heather R. Herndon
Supervisory Patent Examiner.
Technology Center 2100